

REMARKS

In response to the Office Action dated April 8, 2003, claims 1, 7 and 16 are amended, and claims 18 and 19 are submitted. Claims 1-19 are now active in this application. No new matter has been added.

The indication that claims 9-15 and 17 are allowable is acknowledged and appreciated.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103

Claims 1-3, 5, 8 and 16 are rejected under 35 U.S.C. § 102(e) as being anticipated by Chapman et al. (USPN 6,522,421; hereinafter Chapman).

Claims 4 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chapman as applied to claim 1, in view of Ikenoue et al. (USPN 5,671,277; hereinafter, Ikenoue), relied upon by the Examiner as teaching the print condition from the additional information includes the number of prints. The Examiner maintains that it would have been obvious to combine the teaching of Ikenoue with the image formation device of Chapman to meet the terms of the claims.

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Chapman as applied to claim 1, in view of Mahoney et al. (USPN 5,659,639; hereinafter, Mahoney), relied upon by the Examiner as teaching the additional information includes an image processing condition for processing the image data. The Examiner maintains that it would have been obvious to combine the teaching of Mahoney with the image formation device of Chapman to meet the terms of the claims.

To expedite prosecution, claims 1 and 16 are amended to delineate *inter alia*:

a detector detecting additional information from said image data, said additional information including destination information, and said additional information being embedded in said image data as signature information,...

In the system of Chapman, mail address information is attached to the print data file sent from a print server. This mail address is detected at the printer. Upon completion of the print process, the printer status and information are transmitted to the detected address. The art is directed to attaching the mail address information as additional information by a printer driver. Chapman does not disclose or suggest anything regarding *embedding information* into the image (data) per se.

Ikenoue teaches that a book code, a password number, a private number, or the like is embedded in the image (data). However, neither Ikenoue nor Mahoney, considered alone or in combination, discloses or suggests that *additional information of destination information* be embedded in the image (data) per se.

Thus, amended independent claims 1 and 16, as well as dependent claims 2-8 are patentable over Chapman, Ikenoue and Mahoney, considered alone or in combination, and their allowance is respectfully solicited.

NEW CLAIMS

New claims 18 and 19 are submitted, derived respectively from original claims 1 and 16. Each of claims 18 and 19 require, *inter alia*:

 said additional information includes a recording condition to record said image data on the recording medium, said recording condition including the carrying out on the image data at least one of the processes of image data binarization, image data magnification/reduction, modifying the resolution of the image data, and reducing the color of the image data.

Neither Chapman, Ikenoue nor Mahoney, considered alone or in combination, disclose or suggest that the additional information includes a recording condition to record the image data on the recording medium, with the recording condition including the carrying out on the image data at least one of the processes of image data binarization, image data magnification/reduction, modifying the resolution of the image data, and reducing the color of the image data. Consequently, the allowance of claims 18 and 19 is respectfully solicited.

CONCLUSION

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY



Edward J. Wise
Registration No. 34,523

600 13th Street, NW
Washington, DC 20005-3096
(202) 756-8000 EJW:khb\cac
DATE: September 8, 2003
Facsimile: (202) 756-8087